



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/725,032      | 11/29/2000  | Mikio Sanada         | 35.C14959           | 8953             |

5514 7590 12/19/2002

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

NOLAN, SANDRA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

8

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/725,032

Applicant(s)

SANADA ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 23-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-71 are pending, with claims 16-22 under consideration pursuant to the election made in the response dated 22 October 2002 (Paper No. 7), following the restriction requirement made in the 23 September 2002 Office Action (Paper No. 6).  
See below.

### ***Election/Restriction***

2. Applicant's election of claims 16-22 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 04 June 2001 (Paper No. 5) was considered by the examiner.

### ***Specification***

5. The title of the invention is too long and is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Surface Treatment with Polysiloxane Materials".

Art Unit: 1772

6. The abstract of the disclosure is objected to because it is too long. Current USPTO practice calls for an abstract to be 150 words or less in length. Correction is required. See MPEP § 608.01(b).
7. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "The present invention relates to a method of reforming surface of an element for changing characteristics, properties, or the likes to provide desired characteristics and properties, which is applied to the surface of an element. . ." (quoted from page 1, lines 9-13, of the specification).
8. The specification is replete with grammatical and/or typographical errors, as well as passages that are wordy and confusing.

Please clarify the specification.

#### ***Claim Objections***

9. Claims 16-22 are objected to because of the following informalities: they are wordy and confusing, as the following 35 USC 112 rejections illustrate. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1772

11. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 19 recites the limitation "said hydrophilic group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Please correct claim 19.

13. Claims 16-22 are indefinite because they contain confusing and wordy passages.

What does "a partial surface composing at least a part of the surface and provided with a polymer compound" (claim 16, lines 1-3) mean? What does "the direction different from that said partial surface" (claim 16, last two lines) mean?

Please clarify the claims.

14. Claims 16-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that claims 16-22 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the specification. On page 1 of the specification, at lines 18-24, applicant has stated that the invention deals with the treatment of olefinic resin surfaces, such as the surfaces of fibers, particles or containers made of olefinic resins, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims refer to "a element",

with no reference to the kind of "element" or the nature of the technique/material(s) used to act on/with that element.

Please clarify the claims.

the element block in par 0133  
" " " fiber - par. 0134 + 0137.

***Claim Rejections - 35 USC § 102***

15. The rejections in this section are based upon the examiner's understanding of the scope of the claims as they are now worded. As best understood by the examiner, the claims read on the application of a blend or reaction product of polyoxyalkylene molecules with polydimethylsiloxanes to a polyolefinic surface, wherein the surface may have a circular part (per claim 17).

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Taskier (US 3,853,601).

Taskier teaches the coating of a microporous olefinic (col. 7, lines 47+) film (claim 1 of the patent) with a polyoxyethylene polymethyl siloxane (claim 2 of the patent).

The pores of the film are deemed to have circular parts.

18. Claims 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Booth et al (US 5,952,077).

Booth teaches the reaction of surfactant compositions containing applicants' polyalkoxylates and polysiloxane ingredients (col. 2, lines 25+) on the surfaces of polypropylene fibers (col. 1, lines 37+). The polysiloxanes are polydimethylsiloxanes (col. 4, lines 20+). The fibers are subsequently dyed (abstract).

The fibers are deemed to have circular parts.

Art Unit: 1772

In the absence of convincing objective evidence to the contrary, the dyes of Booth are deemed reactive with its treated polyolefin fibers.

**Conclusion**

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan  
Patent Examiner  
Technology Center 1700

SMN/smn  
09725032(8)  
December 14, 2002